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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,545	06/16/2005	Stefan Berg	100915-1P US	7990

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GLOBAL INTELLECTUAL PROPERTY
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WILMINGTON, DE 19850-5437

EXAMINER

MURRAY, JEFFREY H

ART UNIT	PAPER NUMBER
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1624

MAIL DATE	DELIVERY MODE
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03/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,545

Applicant(s)

BERG ET AL.

Examiner

JEFFREY H. MURRAY

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8, 17-24 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) 17-24 and 27-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/003)
Paper No(s)/Mail Date 12/17/2008.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to non-final rejection filed on December 17, 2008. There are seven claims pending and seven claims under consideration. Claims 2, 9-16, 25, 26 and 34 have been cancelled. Claims 17-24 and 27-33 have been withdrawn. This is the second action on the merits.

Withdrawn Rejections/Objections

2. Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

Claim Objections

3. Claim 7 is an independent claim that claims species of the generic claim. Multiple inventions may not be claimed in a single application unless they are species claims which are dependent upon the larger, generic claim, see C.F.R. § 1.141(a). Examiner recommends applicant make this claim dependent from Claim 1, or a broader genus claim from which it depends. No new matter is permitted. Appropriate correction is required.

4. Examiner has found two different interpretations of reading claims 3 and 4. If Claim 3 is read to inherently contain the "optionally substituted by A" term seen in Claim 1, then the following objection is valid. If the examiner does not read this term into claim 3, then the 112, 2nd paragraph rejection is valid in paragraph 8. Examiner suggests applicants attempt to make it clear which of the two interpretations is meant by the applicants.

5. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. If examiner interprets the ring formed in claim 3 to be optionally substituted with A, then Claim 3 does not further limit claim 1.

Claim Rejections - 35 USC § 112, 2nd paragraph

6. Claims 1 and 3-8 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The scope of "heteroaryl" and "heterocyclyl" still requires clarification. Applicants have not defined these terms with reasonable clarity. The terms are defined with non-limiting examples making them impossible to pin down. For example, when one states C₁-C₄ alkyl, there are a small finite number of possibilities that exist in that set. One ordinarily skilled in the art realizes and understands this. However when one states, "heteroaryl" and then provides a list of examples and states the list is non-limiting, how can this be considered definite? One skilled in the art could instantly envision well over one hundred ring systems that qualify under this vague definition. Does the applicant wish to claim a thiophene or a pyrazolopyrimidine? If applicant desires a pyridyl ring, is it a 2-pyridyl, 3-pyridyl or 4-pyridyl ring? Applicant must narrow such broad terminology by either eliminating such a broad definition or by inserting the specific ring systems

they wish to cover into the claim themselves. No new matter permitted. Appropriate correction is required.

8. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "optionally substituted by A" and depends from Claim 3. There is insufficient antecedent basis for this limitation in the claim. If examiner interprets claim 3 to not inherently contain the term "optionally substituted by A" then Claim 4 is a broadening of claim 3. No new matter permitted. Appropriate correction required.

Conclusion

9. Claims 1 and 3-8 are rejected.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is (571) 272-9023. The examiner can normally be reached on Mon-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a US PTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/
Examiner, Art Unit 1624

/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624

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